

Appl. No. 10/733,661
Amdt. dated Aug. 5, 2005
Reply to Office Action of Mar. 8, 2005

REMARKS/ARGUMENTS

1. The Examiner rejected claims 1, 2, 4-7, 11, 14, and 15 under 35 U.S.C. § 102(b) as being anticipated by Tsuijita (U.S. Patent No. 6,078,822). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of Mauney et al. (U.S. Patent Application Publication No. 2005/0032475 A1). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of Amin et al. (U.S. Patent No. 5,995,830) and Nojima et al. (U.S. Patent No. 5,832,386). Claims 9, 10, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of Saegusa et al. (U.S. Patent No. 4,876,708). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of the Examiner's own Official Notice. Reconsideration of this application is respectfully requested in view of the amendments and/or remarks provided herein.

Rejections under 35 U.S.C. § 102(b)

2. Claims 1, 2, 4-7, 11, 14, and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tsuijita. In particular, the Examiner asserts that the notification signal transmitted by Tsuijita's home independent base station (401) notifying Tsuijita's dual purpose mobile station (402) of an incoming *cellular telephone call* reads on Applicants' claimed "receiving an incoming *two way communication*" (emphasis added) and that the transmission of a silent transmission requirement from Tsuijita's mobile station (402) to the home independent base station (401) instructing the home independent base station (401) to perform silent transmission (see col. 13, lines 7-10; col. 15, lines 2-6) reads on Applicants' claimed placing the cordless telephone in a low RF hold mode. Applicants strongly disagree with the Examiner's characterization of the present invention in view of the cited reference. In particular, the Examiner has overbroadly construed the phrase "two way communication," as clearly defined in context of Applicants' specification, to be equivalent to a cellular telephone call as disclosed in Tsuijita. In addition, the Examiner has overbroadly construed Applicants' phrase "placing the cordless telephone call in a hold mode" given the context of such mode as set forth in Applicants' specification. Such overbroad construction is not permitted by the Federal Circuit.

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In the very recent case of *Phillips v. AWH Corp.*, Nos. 03-1269, 03-1286, 2005 WL 1620331, at * 1 (Fed. Cir. July 12, 2005) (en banc), the Federal Circuit clarified in great detail the proper procedure for construing claims of a patent (or application). During its discourse, the Court emphasized the importance of the specification in the claim construction process, noting that "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but [also] in the context of the entire patent, including the specification." *Id.* at *5. Thus, claim construction must not be done in a vacuum, but rather must be reasonable in view of the patent specification and prosecution history. See *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005); see also *Kinik Co. v. Int'l Trade Comm'n*, 362 F.3d 1359, 1365 (Fed. Cir. 2004) ("The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history"). As the Federal Circuit explained only a few weeks ago, "[t]he claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument, . . . , consisting principally of a specification that concludes with claims. For that reason, claims 'must be read in view of the specification, of which they are part'." *Phillips*, 2005 WL 1620331, at * 7 (internal citations omitted). Thus, in performing her analysis of the claims of the present application, the Examiner must not only rely upon the claim language, but must instead give the claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *Id.* at *9 (citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). As noted above, one of ordinary skill in the art would look to the specification to understand the selected claim language without specifically importing limitations from the specification into the claims. See *id.* at *16.

Applying the foregoing law to the instant case, it is clear from the context of Applicants' specification (see, e.g., FIG. 1; page 4, lines 4-13; and page 7, lines 13-24) that a "two way communication" as recited in Applicants' claims is a conventional two-way radio communication over a shared radio channel, and is *not* a radiotelephone call. The entire focus of Applicants' invention, as set forth in the specification, is on the ability of a wireless communication device to switch between a cordless telephone call and a two way radio call (referred to in Applicants' specification as a "group talk" or group call (see page 2, line 7) and alternatively referred to in the industry as a "dispatch call"), while placing the cordless telephone

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call on hold in such a manner that interference is substantially mitigated over the wireless link supporting the group call. Applicants' invention does not at all address switching between a cellular telephone call and a cordless telephone call or otherwise between two radiotelephone calls. However, based on the disclosure of the Tsuijita reference cited by the Examiner, it appears that the Examiner has overbroadly and improperly construed the claimed phrase "two way communication" to include a cellular telephone call as disclosed in Tsuijita. However, one of ordinary skill in the art, having read Applicants' specification, would not have construed such phrase in the manner in which the Examiner construed the phrase. Rather, because the focus of Applicants' specification is very clearly directed at a dual mode device capable of engaging in cordless telephone calls and two way group calls, one of ordinary skill in the art would clearly construe the recited phrase "two way communication" to mean a group call, not a radiotelephone call.

Similarly, the Examiner has overbroadly and improperly construed Applicants' phrase "placing the cordless telephone call in a hold mode" to be equivalent to transmission of a silent transmission requirement from Tsuijita's mobile station (402) to the home independent base station (401) instructing the home independent base station (401) to perform silent transmission (see col. 13, lines 7-10; col. 15, lines 2-6). Tsuijita does not specifically disclose what is meant by performing "silent transmission"; however, Applicants submit that a reasonable interpretation of such phrase is that the cordless base station (401) stops transmitting to the mobile station (402) after receiving the silent transmission requirement from the mobile station (402).

By contrast, Applicants clearly describe "placing the cordless telephone call in a hold mode" on pages 8 and 9 of Applicants' specification. Such mode causes the wireless communication device to refrain from maintaining a full duplex communication link with the cordless base station so as to mitigate the interference and noise generated on the radio channel supporting the group call (see p. 8, lines 6-10). In a preferred embodiment, while the cordless telephone call is in the hold mode, the wireless communication devices ceases or stops transmitting to the cordless base station, but continues receiving broadcast messages from the cordless base station (see p. 9, lines 18-21). Thus, during Applicants' "hold mode", there is no cessation of transmissions from the cordless base station to the wireless device. As a result,

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Applicant's "hold mode" cannot reasonably be construed to encompass the silent transmission mode of Tsuijita.

Nevertheless, in order to clarify the recitations of Applicants' claims, but not to distinguish Applicants' claimed invention from the disclosure of Tsuijita, Applicants have amended independent claims 1 and 11 to more clearly recite the subject matter that was already inherently present in Applicants' originally filed claims. In other words, Applicants have clarified that the cordless telephone call is over one wireless link and the group call is over a different wireless link capable of supporting simultaneous communication between the wireless device and multiple other wireless devices, and that the cordless telephone call is placed on hold so as to mitigate interference on the wireless link supporting the group call. Tsuijita provides no comparable disclosure or suggestion. Rather, Tsuijita discloses a system and process for switching between a cordless telephone call and a cellular telephone call whereby the cordless base station receives the signaling from the cellular telephone system and notifies the mobile station that it has an incoming cellular telephone call. Tsuijita does not at all disclose or suggest a multi-mode wireless device capable of receiving both a cordless telephone call and a two-way group call. As a result, Tsuijita does not address, nor is he even interested in, mitigating interference on a wireless link supporting a group call. Therefore, Tsuijita fails to disclose each and every limitation recited in Applicants' independent claims 1 and 11.

Accordingly, Applicants respectfully request that the rejection of independent claims 1 and 11 under 35 U.S.C. § 102(b) be withdrawn and said claims be passed to allowance.

Claims 2, 4-7, 14, and 15 are dependent upon claims 1 and 11, which claims have been shown allowable above. Therefore, since claims 2, 4-7, 14, and 15 each introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claims 2, 4-7, 14, and 15 are not disclosed or suggested by the cited references. Accordingly, Applicants respectfully submit that claims 2, 4-7, 14, and 15 are in proper condition for allowance.

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Rejections under 35 U.S.C. § 103(a)

3. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of Mauney et al. Claim 3 is dependent upon claim 1, which claim has been shown allowable above. Therefore, since claim 3 introduces additional subject matter that, when considered in the context of the recitations of claim 1, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claim 3 are not disclosed or suggested by the cited references. Accordingly, Applicants respectfully submit that claim 3 is in proper condition for allowance.

4. Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of Amin et al. Claim 8 is dependent upon claim 1, which claim has been shown allowable above. Therefore, since claim 8 introduces additional subject matter that, when considered in the context of the recitations of claim 1, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claim 8 are not disclosed or suggested by the cited references. Accordingly, Applicants respectfully submit that claim 8 is in proper condition for allowance.

5. Claims 9, 10, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of Saegusa et al. Claims 9, 10, and 16 are dependent upon claims 1 and 11, which claims have been shown allowable above. Therefore, since claims 9, 10, and 16 each introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claims 9, 10, and 16 are not disclosed or suggested by the cited references. Accordingly, Applicants respectfully submit that claims 9, 10, and 16 are in proper condition for allowance.

6. Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuijita in view of the Examiner's own Official Notice. Claims 12 and 13 are dependent upon claim 11, which claim has been shown allowable above. Therefore, since claims 12 and 13 each introduce additional subject matter that, when considered in the context of the recitations of

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claim 11, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claims 12 and 13 are not disclosed or suggested by the cited references. Accordingly, Applicants respectfully submit that claims 12 and 13 are in proper condition for allowance.

Amendments to the Specification

7. Applicant has herein amended the title and paragraphs 0004, 0012-0014, 0017-0019, 0021-0024, 0026, 0028, and 0029 of the specification to correct minor informalities contained therein. No new matter has been added by such amendments.

Other Amendments to the Claims

8. Applicants have herein amended all of the claims to correct minor informalities therein, to broaden the claims in certain respects, and to make the text of dependent claims consistent with the amendments made to their respective base claims. Some of the dependent claims were also amended to recite disclosed, but previously unclaimed, subject matter. None of the amendments to any of the claims were intended to narrow the claims in any manner or were made for any purpose related to patentability. Applicants submit that all such claim amendments are fully supported by Applicants' originally filed specification.

New Claims

9. Applicants have herein added new claims 17-20 directed to additional features of the present invention. Applicants submit that such claims are fully supported by Applicants' originally filed specification and are patentably distinct from the cited references of record. Accordingly, Applicants request that the Examiner pass new claims 17-20 to allowance. With the addition of claims 17-20, twenty claims remain pending in the present application, three of which are independent. Applicant had previously paid for examination of twenty claims, three of which could be independent. As a result, no additional fee is believed due for examination of the four newly presented claims. However, if any additional fees are deemed to be due in order to examine new claims 17-20, please charge such additional fees to the undersigned's Deposit Account No. 50-1111.

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10. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application.

Respectfully submitted,

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